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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/788,732

02/27/2004

Lee D. Saathoff

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EXAMINER

GOLOBOY, JAMES C

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

06/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/788,732	Applicant(s) SAATHOFF ET AL.	
	Examiner James Goloboy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 20-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay and Field.

The rejection is adequately set forth in paragraph 9 of the office action mailed 9/24/07, which is incorporated here by reference.

2. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay and Field as applied to claims 20-35 above, and further in view of Ohtani.

The rejection is adequately set forth in paragraph 10 of the office action mailed 9/24/07, which is incorporated here by reference.

3. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay and Field as applied to claims 20-35 above, and further in view of Watts.

The rejection is adequately set forth in paragraph 11 of the office action mailed 9/24/07, which is incorporated here by reference.

Response to Arguments

4. Applicant's arguments have been fully considered but they are not persuasive. Applicant reiterates previous arguments that "power transmission fluid" is a claim limitation rather than an intended use, and that Lowe does not teach a tertiary amine containing one short chain hydrocarbon group and two relatively long chain

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hydrocarbon groups. The examiner maintains the positions set forth in previous office actions. Applicant has not provided a definition of “power transmission fluid” that excludes the fluid of Lowe, Papay, and Field. Lowe teaches that the tertiary amine has at least one long carbon chain. The range clearly includes two long carbon chains as recited in the claims.

Applicant argues that Lowe “expresses preference” for concentrations of tertiary amine outside the claimed range. In column 2 lines 65-68 Lowe teaches that in a “preferred embodiment”, the tertiary amine is present in the amount of 0.001 to 5% by weight, overlapping the claimed range. Lowe teaches that “more preferably”, the amine is present in an amount of 0.01 to 0.3% by weight, but a more preferred embodiment does not constitute a teaching away from a preferred embodiment.

Applicant has submitted a declaration under 37 CFR 1.132, signed by Saathoff and dated 3/16/09, allegedly demonstrating the unexpectedly superior results obtained by the claimed composition. The declaration does not provide any information about the inventive and comparative fluids other than the tertiary amine present in each—the identity of the base oil and additional additives (including the claimed ashless dispersant) are not given, nor are any concentrations given. It is therefore not even clear that the inventive fluid falls within the scope of the claims. Nonetheless, applicant clearly has not established unexpected results commensurate with the scope of the claims, as there is only one inventive fluid, while the claimed composition can comprise any base oil, any concentration of any ashless dispersant, and 0.5 to 8% by weight of a wide variety of tertiary amines.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797